

## **REMARKS:**

Claims 1-7, 9, 10, 12-14 and 16 are currently pending in the application. Claims 1, 2, and 4 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 2,984,005 to Vincent J. Evich ("Evich"). Claim 3 stands rejected under 35 U.S.C. § 103(a) over Evich. Claims 5-7, 9, 10, 12-14, and 16 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 3,203,095 to Thomas F. Nelson ("Nelson") in view of Evich in view of U.S. Design Patent No. 373,712 to John C. Bridgers ("Bridgers") and in further view of U.S. Patent No. 3,417,469 to Cousins et al. ("Cousins").

Claims 8, 11, 15, and 17-19 have been previously cancelled without prejudice. The Applicant reserves his right to pursue claims 8, 11, 15, and 17-19 in a continuation application.

## **REJECTION UNDER 35 U.S.C. § 102(b):**

Claims 1, 2, and 4 stand rejected under 35 U.S.C. § 102(b) over Evich.

The Examiner alleges that Evich discloses a flexible rubber guard (65) which is fully capable of being detachably attached to a housing of a battery powered reciprocating saw if such a saw is so provided. (10 May 2005 Office Action, Page 2). The Applicant has reviewed Evich in detail, particularly looking for a flexible rubber guard which is fully capable of being detachably attached to a housing of a battery powered reciprocating saw, relied upon by the Examiner. However, Evich fails to disclose each and every limitation recited by claims 1, 2, and 4. Thus, the Applicant respectfully submits that claims 1, 2, and 4 patentably distinguish over Evich.

For example, with respect to independent claim 1, this claim recites:

An article of manufacture which comprises a guard sized and configured for detachable attachment to a housing of a reciprocating saw independent of the saw, which saw comprises at least one saw blade, wherein the guard forms at least one flexible surface which in turn defines

an aperture which extends through the guard and which aperture is sized and configured to allow the blade to extend therethrough, and wherein at least a portion of the flexible surface contacts at least a portion of the blade when the blade extends through the aperture so that at least a portion of the guard flexes with the movement of the blade to thereby facilitate the maintenance of contact between the blade and the surface in order to inhibit entry of liquid or particulate matter into the housing when the saw is in use. (Emphasis Added).

Dependent claims 2 and 4 depend from independent claim 1 and recite similar limitations. Evich fails to disclose each and every limitation of claims 1, 2, and 4.

For example, the Examiner asserted that Evich discloses a flexible rubber guard (65) which is fully capable of being detachably attached to a housing of a battery powered reciprocating saw if such a saw is so provided. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Evich.

The Applicant respectfully submits that Evich does not disclose a guard that is sized and configured for detachable attachment to a housing of a reciprocating saw independent of the saw. Rather, Evich describes a self-contained, hand-held, power driven knife, comprising a boot attached to the handle of the knife. (Column 3, Line 49 through Column 4, Line 8). Evich does not disclose, suggest, or even hint that the boot is fully capable of being detachably attached. Rather, Evich discloses a self-contained, hand-held, power driven knife that as part of the self-containment comprises a boot that is attached to the handle of the self-contained knife.

The Applicant further submits that Evich has nothing to do with independent claim 1 limitation regarding a battery powered reciprocating saw. Rather, Evich discloses a self-contained, hand-held, power driven knife. (Abstract). Evich fails to disclose, teach, or suggest that guard (65) is attached to a battery powered reciprocating saw. Thus, Evich cannot provide a flexible rubber guard (65) which is fully capable of being detachably attached to a housing of a battery powered reciprocating saw since Evich does not disclose, suggest, or even hint at the use of a battery

powered reciprocating saw, or any other type of reciprocating saw.

Thus, the allegation in the present Office Action that Evich discloses all of the claimed features is respectfully traversed. Further, it is noted that the Examiner provides no concise explanation as to how Evich is considered to anticipate all of the limitations in independent claim 1. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. The Applicant respectfully points out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that the Examiner has failed to establish a prima facie case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Evich, because Evich fails to identically disclose every element of the Applicant's claimed invention, arranged as they are in Applicant's claim.

With respect to dependent claims 2 and 4 which depend from independent claim 1, claims 2 and 4 are also considered patentably distinguishable over Evich. Thus, dependent claims 2 and 4 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for the reasons set forth herein, the Applicant submits that claims 1, 2, and 4 are not anticipated by Evich. The Applicant further submits that claims 1, 2, and 4 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1, 2, and 4 under 35 U.S.C. § 102(b) be reconsidered and that claims 1, 2, and 4 be allowed.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claim 3 stands rejected under 35 U.S.C. § 103(a) over Evich. Claims 5-7, 9, 10, 12-14, and 16 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 3,203,095 to Thomas F. Nelson ("Nelson") in view of Evich in view of U.S. Design Patent No.

373,712 to John C. Bridgers ("Bridgers") and in further view of U.S. Patent No. 3,417,469 to Cousins et al. ("Cousins").

The Applicant respectfully submits that Evich, either individually or in combination with the general knowledge in the art at the time of the invention, fails to disclose, teach, or suggest each and every element of claim 3. The Applicant further submits that Evich, Nelson, Bridgers, or Cousins either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5-7, 9, 10, 12-14, and 16. Thus, the Applicant respectfully traverses the Examiner's obviousness rejection of claims 3, 5-7, 9, 10, 12-14, and 16 under 35 U.S.C. § 103(a) over the proposed combination of Evich, Nelson, Bridgers, or Cousins either individually or in combination.

The Applicant further submits that the Examiner acknowledges that Evich fails to disclose the emphasized limitations of dependent claim 3. Specifically, the Examiner acknowledges that Evich fails to show a guard made of "ethylene propylene diene monomer". (10 May 2005 Office Action, Page 3). However, the Examiner asserts that to select "a well known flexible material such as ethylene propylene diene monomer" for replacement of Evich's rubber guard (65), would have been obvious to one having ordinary skill in the art. The Applicant respectfully traverses the Examiner's assertions regarding the obviousness of Claim 3.

For example, with respect to dependent claim 3, this claim recites:

An article according to Claim 2 wherein the guard is formed at least in part from ethylene propylene diene monomer. (Emphasis Added).

Dependent claim 7 depends from independent claim 5 and recites similar limitations. Evich fails to disclose each and every limitation of claims 3 and 7.

The Applicant respectfully submits that these purported advantages relied upon by the Examiner of replacing the rubber guard of Evich with "a well known flexible

material such as ethylene propylene diene monomer" are nowhere disclosed, taught, or suggested in Evich either individually or in combination with the general knowledge in the art at the time of the invention. The Applicant respectfully requests the Examiner to point to the portions of Evich or to the general knowledge in the art which contain the teaching, suggestion, or motivation to: (1) demonstrate that ethylene propylene diene monomer is in fact a well known flexible material and (2) combine these references for the purpose of replacing the rubber guard of Evich with a well known flexible material such as ethylene propylene diene monomer. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Evich either individually or in combination with the general knowledge in the art at the time of the invention.

The Applicant further submits that the Examiner acknowledges that Nelson fails to disclose the emphasized limitations of claims 5-7, 9, 10, 12-14, and 16. Specifically, the Examiner acknowledges that Nelson fails to disclose a flexible guard for inhibiting entry of liquid or foreign matter into the housing. (10 May 2005 Office Action, Page 3). However, the Examiner asserts that Evich discloses a cutting device (not a reciprocating saw) comprising (not detachable) a flexible rubber guard (65) (not even ethylene propylene diene monomer) enclosing (again not detachable) a forward end of a knife housing (again not an electrical reciprocating saw or even a battery powered reciprocating saw). The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Nelson, Evich, and Bridgers.

The Examiner further asserts that it would have been obvious to one skilled in the art to modify Nelson by enclosing the forward end of the knife housing (10) (not a reciprocating saw) with a flexible rubber guard (not even ethylene propylene diene

monomer) to prevent foreign matter or fluids from entering the interior of the knife housing (again not an electrical reciprocating saw or even a battery powered reciprocating saw) as taught by Evich. However, the Examiner acknowledges that even assuming one skilled in the art would modify Evich and Nelson. Nelson as modified, would still fail to show the guard being removed (not detachable) from the knife housing. In essence, the Examiner acknowledges that Evich fails to disclose, teach, or suggest a guard that is sized and configured for detachable attachment to a housing of a reciprocating saw independent of the saw. Thus, the Examiner has rendered moot the above anticipated rejection of claims 1, 2, and 4 under 35 U.S.C. § 102(b) and the above obvious rejection of claim 3 under 35 U.S.C. § 103(a).

The Examiner still further asserts that somehow Bridgers discloses the acknowledged shortcomings in Nelson and Evich. The Applicant respectfully submits that Bridgers has nothing to do with the claim 5-7, 9, 10, 12-14, and 16 limitations or even the claim 1-4 limitations regarding a guard that is sized and configured for detachable attachment to a housing of a reciprocating saw independent of the saw. Rather Bridgers is a design patent illustrating a weed trimmer debris shield attached to a weed trimmer via bolts, nuts and a bracket. (Description). Thus, Bridgers fails to disclose, suggest, or even hint that the a guard is sized and configured for detachable attachment to a housing of a reciprocating saw, a knife housing, a weed trimmer or even any other compatible cutting device.

The Applicant yet further submits that the Examiner acknowledges that Nelson fails to disclose the emphasized limitations of claims 9, 12, and 16. Specifically, the Examiner acknowledges that Nelson fails to disclose the use of a battery as a power source. (10 May 2005 Office Action, Page 4). However, the Examiner asserts that the cited portions of Cousins disclose the acknowledged shortcomings of Nelson. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Cousins. The Applicant respectfully submits that Cousins has nothing to do with the claim 9, 12, or 16 limitations regarding a cordless reciprocal saw powered by a battery. Rather, Cousins discloses an electrically operated slicing knife with a hollow

handle. (abstract). Cousins fails to disclose, teach, or suggest that the cordless reciprocal saw is powered by a battery.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Nelson, Evich, Bridgers, or Cousins, either individually or in combination. The Examiner has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Examiner merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nelson, Evich, Bridgers, or Cousins to achieve the Applicant's claimed invention.

The Applicant further submits that these purported advantages relied on by the Examiner are nowhere disclosed, taught, or suggested in Nelson, Evich, Bridgers, or Cousins either individually or in combination. The Applicant respectfully requests the examiner to point to the portions of Nelson, Evich, Bridgers, or Cousins which contain the teaching, suggestion, or motivation to combine these references for the purpose of achieving the Applicant's claimed invention. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Examiner fails to provide proper motivation for combining the teachings of Nelson, Evich, Bridgers, or Cousins either individually or in combination.

For at least the reasons set forth herein, independent claims 1, 5, 10 and 13 are considered patentably distinguishable over Nelson, Evich, Bridgers, or Cousins either individually or in combination. Furthermore, dependent claims 2-4 which depend from independent claim 1, dependent claims 6, 7, and 9 which depend from independent claim 5, dependent claim 12 which depends from independent claim 10, and dependent claims 14 and 16 which depend from independent claim 13 are also considered patentably

distinguishable over Nelson, Evich, Bridgers, or Cousins either individually or in combination. As mentioned above, each of independent claims 1, 5, 10 and 13 are considered patentably distinguishable over Nelson, Evich, Bridgers, or Cousins either individually or in combination. Thus, dependent claims 2-4, 6, 7, 9, 12, 14, and 16 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicant submits that claims 3, 5-7, 9, 10, 12-14, and 16 are not rendered obvious by the proposed combination of Nelson, Evich, Bridgers, and Cousins. The Applicant further submits that claims 3, 5-7, 9, 10, 12-14, and 16 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 3, 5-7, 9, 10, 12-14, and 16 under 35 U.S.C. § 103(a) be reconsidered and that claims 3, 5-7, 9, 10, 12-14, and 16 be allowed.

#### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.



4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things

co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence

of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.


No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees that are necessary, or credit any overpayments, to **Deposit Account No. 502806**.

**Please link this application to Customer Nos. 50779 and 38441 so that its status may be checked using the PAIR System.**

Respectfully submitted,

Date

7/11/05

  
James E. Walton, Registration No. 47,245  
Michael Alford, Registration No. 48,707  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (Voice)  
(817) 447-9954 (Facsimile)  
jim@waltonpllc.com

**CUSTOMER NOS. 50779 AND 38441**

**ATTORNEYS FOR APPLICANT**